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09/540,011	03/31/2000	Peter J. Kight	3350-31F	2558

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Washington, DC 20009

EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/540,011

Applicant(s)

KIGHT ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 36-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. Amendment C, paper number 9 and request for drawing change, paper number 10, received on 11/27/02 are entered. Claims 36-50 are amended. Currently claims 36-50 are pending for examination.

***Response to Arguments***

2. Applicant's arguments filed on 11/27/2002 have been fully considered but they are moot in view of the new grounds of rejection necessitated due to amendments.

***Priority***

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The second application must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ 2d 1077 (Fed. Cir. 1994). The applicant has claimed continuity and priority to co-pending application for U.S. Patent 09/250675, filed February 16, 1999, which was abandoned on August 7, 2002, which was s continuation U.S.

Pat. Ser. No. 08/372,620, filed January 13, 1995, which became a U.S. Pat. No 5,873,072 on February 16, 1999, which was a continuation of co-pending application for U.S. Patent. Ser. No. 07/736,071, filed on July, 25, 1991, which became a U.S. Patent No. 5,383,113 on January 17, 1995, and each having the common assignee of the present invention, see Pre-amendment # B, paper number 5, received on March 31, 2000. With reference to the instant application, the drawings contain subject matter which was not described in the specification of the application Ser. No. 07/736,071 filed on July 25, 1991, and also there is a change in the text of specification, as detailed below:

(i). FIG.1 of the patent, '113 shows flow of data to and fro between elements Consumer database, 22 and FIF File, 24 as against only unidirectional flow of data from 24, FIF File to Consumer database 22 in the patent, '113. The disclosure does not support this change that is, the reverse action from consumer database 22 editing the data in FIF 24 (see disclosure, page 5, line 16-page 6, line 5). Information for FIF 24 is collected from the banking institution and the data entry in consumer database 22 is done from the information supplied by the consumer. The function of FIF 24 is to check the accuracy of the financial institution's routing number and the bank account number while entering the data supplied by the consumer and if the numbers do not correspond with the existing information in FIF 24 the data entry is rejected, corrected and repeated and the consumer database 22 is updated.

(ii). The FIG.2 of instant application, '011 shows a new interface element of interaction between elements Add a Merchant, 32 and Make Payment, 32. This element was not included in the patent, '113. Further, the disclosure does not support this new addition (see col.3, line 30-col.4, line 41). The disclosure specifies a separate process for adding merchants by a) either consumer informs the data about merchants to service provider—which can be done by mail as being done when establishing consumer data or b) to the processor, 40 of the system (see

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col.3, lines 30-54). After establishing the merchant data (col.3, lines 30-54) and consumer data (col.2, line 38-col.3, line 14), payment process is initiated (see col.3, line 55-col.4, line 28).

(iii). FIG.3 of instant application, '011 includes a new element of "rejects" by processor, 40 and this "rejects" element was not included in the patent, '113. This change indicates that the processor 40 is enabled to reject instructions being received from the consumer's telecommunication device and this limitation is not supported in the disclosure. The disclosure of patent, '113 specifies that the consumer initiates the payment instructions via a telecommunication device wherein he or she accesses his merchant list, inputs the merchant payment date and amount on his/her computer screen and transmits this information to the service provider or he or she communicates the same instructions via a telephone to the service provider (see col.3, line 55-col.4, line 28, FIG.1, FIG.3). After receiving the instructions from the consumer the payment cycle is initiated separately, see FIGS. 4a, 4b, 4c, and other functions like creation of the consumer payment table 38, validation process for checking duplicate payments and sending the duplicates to a reject file (see col.4, lines 29-52, col.5, lines 42,). Moreover, col.1, line-66-col.2, line 14 describes the objectives of the invention and explicitly states that only after receiving payment instructions from the consumer they are applied, using the computer software of the present invention to examine various files to determine appropriate form of payment, validating of transactions, etc..

(iv) The disclosure of the patent, '113, discloses explicitly to use "the software of the present invention " to compare new merchants to MMF 42 and cross-reference them to the pay table if the merchant record exists (see col.4, lines 38-41). However, the disclosure in the instant application does not show such explicit use of the software of the present invention "to compare new merchants to MMF 42 and cross-reference them to the pay table if the merchant record exists" is absent from the instant application,'011. This implies that the applicant is

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broadening his scope to use the software " to compare new merchants to MMF 42 and cross-reference them to the pay table if the merchant record exists".

With the above changes in the drawings and in the text of the specification the instant application may constitute a continuation-in-part of the patent, '113. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

In view of the foregoing, priority cannot be allowed to the patent, '113 and instead it is restricted to the application Ser. No. 08/372,620, filed January 13, 1995. See MPEP 2163.05: Changes to the Scope of Claims: The failure to meet the written description requirement of 35 U.S.C. 112, first paragraph, commonly arises when the claims are changed after filing to either broaden or narrow the breadth of the claim limitations, or to alter a numerical range limitation or to use claim language which is not synonymous with the terminology used in the original disclosure. To comply with the written description requirement of 35 U.S.C. 112, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. See MPEP § 2163 for examination guidelines pertaining to the written description requirement.

Note: Therefore, for further art rejection, priority date of January 13, 1995 will be considered.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 36, 38, 41, 43-46, and 48-50 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 36, 38, 41, 43, 46, 48, recite the limitation of receiving a bill payment request via a network associated with a merchant on behalf of the consumer, determining if the merchant associated with a request to pay a bill received via a network is included in the merchant database and if not adding the merchant to the master merchant file database. This subject matter was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See page 7, line 7-page 8, line 9, which disclose that the session of initiating payment of bills by the consumer via a communicating telecommunication device (see at least FIG.2, element 34) consists of consumer accessing his merchant list, inputting the payment dates and amounts and transmitting this information to the service provider. While transmitting these payment instructions the disclosure does not teach determining if the merchant associated with the payment request is in the MMF 42 or not or there is a need to add the merchant. Rightly so, because, the disclosure teaches to establish the merchants separately (see at least, page 6, line 15-page 7, line 6) and as such when the consumer initiates the request for bill payment he is able to access his merchant list (see at least, page 7, lines 7-9).

Claims 44-45, and 49-50, recite the limitations of a network interface configured to receive a plurality of payment records from a consumer, each payment record identifying a merchant, and a processor configured to search the master file database to determine if the

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merchant identified in each of the plurality of payment records is included in the master merchant file database if not to add the merchant to MMF 42. This subject matter was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See page 7, line 7-page 8, line 9, which disclose that the session of initiating payment of bills by the consumer via a communicating telecommunication device (see at least FIG.2, element 34) consists of consumer accessing his merchant list, inputting the payment dates and amounts-plurality of payment record- and transmitting this information to the service provider. While transmitting these payment records the disclosure does not teach determining if the merchant associated with the payment records is in the MMF 42 or not. Rightly so, because at the time of start of the payment session the consumer accesses his merchant list, which was already established separately in advance, (see at least, page 6, line 15-page 7, line 6) and the session of establishing or adding merchants is not interconnected with the session of transmitting payment instructions-plurality of payment records-to the processor. The disclosure further teaches the creation of a payment table 38 and at that time the consumer records are edited and new records are added to the consumer's pay table 38. The records of pay table 38 are compared and cross-referenced to MMF 42 and MMF 42 does not contain new merchants they are added. But this process is separate and is not linked to the session of receiving payment instructions/records from the consumer via a network.

6. Claims 36, 38, 41, 43-46, and 48-50 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 36, 38, 41, 43, 46, 48, recite the limitation of receiving a bill payment request via a network associated with a merchant on behalf of the consumer, determining if the merchant associated with a request to pay a bill received via a network is included in the merchant database and if not adding the merchant to the master merchant file database. This subject matter was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See page 7, line 7-page 8, line 9, which disclose that the session of initiating payment of bills by the consumer via a communicating telecommunication device (see at least FIG.2, element 34) consists of consumer accessing his merchant list, inputting the payment dates and amounts and transmitting this information to the service provider. While transmitting these payment instructions the disclosure does not teach determining if the merchant associated with the payment request is in the MMF 42 or not or there is a need to add the merchant. Rightly so, because, the disclosure teaches to establish the merchants separately (see at least, page 6, line 15-page 7, line 6) and as such when the consumer initiates the request for bill payment he is able to access his merchant list (see at least, page 7, lines 7-9).

Claims 44-45, and 49-50, recite the limitations of a network interface configured to receive a plurality of payment records from a consumer, each payment record identifying a merchant, and a processor configured to search the master file database to determine if the merchant identified in each of the plurality of payment records is included in the master merchant file database if not to add the merchant to MMF 42. This subject matter was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See page 7, line 7-page 8, line 9, which disclose that the session of initiating payment of bills by the consumer via a communicating telecommunication device (see at least FIG.2, element 34)

consists of consumer accessing his merchant list, inputting the payment dates and amounts-plurality of payment record- and transmitting this information to the service provider. While transmitting these payment records the disclosure does not teach determining if the merchant associated with the payment records is in the MMF 42 or not. Rightly so, because at the time of start of the payment session the consumer accesses his merchant list, which was already established separately in advance, (see at least, page 6, line 15-page 7, line 6) and the session of establishing or adding merchants is not interconnected with the session of transmitting payment instructions-plurality of payment records-to the processor. The disclosure further teaches the creation of a payment table 38 and at that time the consumer records are edited and new records are added to the consumer's pay table 38. The records of pay table 38 are compared and cross-referenced to MMF 42 and MMF 42 does not contain new merchants they are added. But this process is separate and is not linked to the session of receiving payment instructions/records from the consumer via a network.

See MPEP 2163.05: Changes to the Scope of Claims: The failure to meet the written description requirement of 35 U.S.C. 112, first paragraph, commonly arises when the claims are changed after filing to either broaden or narrow the breadth of the claim limitations, or to alter a numerical range limitation or to use claim language which is not synonymous with the terminology used in the original disclosure. To comply with the written description requirement of 35 U.S.C. 112, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. See MPEP § 2163 for examination guidelines pertaining to the written description requirement.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

**Recent Statutory Changes to 35 U.S.C. § 102(e)**

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.

8. Claims 36-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Landry (US Patent 5,956,700).

With regards to method claims 36-40, Landry teaches receiving, via a network, a request to pay a bill associated with a merchant/a list of merchants/payment records on behalf of the consumer, determining if the merchant (s) is included in a master merchant file database which includes information on merchants identified by the other consumers as well, adding the merchant (s) to the master merchant file database if the merchant (s) is determined to not be included in the master merchant file database and processing the request to generate an instruction to pay the bill (see at least *FIGs.3 [is the schematic diagram showing receiving bill payment requests from consumers 112, 120 via a network 114]*, *7 [a flow chart showing the bill payment activity 10A]*, *8A, 8B, 8C, 8D, 8E, 8F, 8G, 8H, 8I, 8J, 8K, 8L, col.19, line 15-col.23, line 20, "...Payors have the ability to add, modify.....a Child-Payee records.....Add a Child-Payee Record FIG.8G shows the steps.....system 100 checks the Payee Files to ensure that the Payee to be added.....is an existing Payee.....If a Payee Record does not exist on system 100.....Payor request for additions of new Payee Records be preferably accomplished through interactive devices....."*. Note: Child-Payee corresponds to merchant associated with a request to pay bill from the consumer and Payee database, 20 in FIG 3 corresponds to merchant master file database which includes merchant information from other consumers as well. ).

With regards to system claims 41-45, and article of manufacture claims, 46-50, their limitations correspond to the limitations of method claims 36-40 and they are analyzed and rejected based on the same rationale.

**Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US patents 5,326,959 to Perazza, and 5,465,206 to Hilts et al. teach automatic bill payment system from remote terminals via a network and using a master merchant file database.

(ii) Streeter, Bill, "The future is here, and it's on tv", ABA Banking Journal, November, 1980, extracted from Internet from Corporate business source database on 01/28/2003, discloses automatic bill payment system from remote terminals via a network and using a master merchant file database.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg  
Examiner  
Art Unit 3625

YCG  
February 6, 2003

  
WYNN W. COGGINS  
SUPERVISORY PATENT EXAMINER  
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